

REMARKS

Claims 1-20 are presently pending. Claims 1-20 have been rejected. No claims have been allowed. No claims have been amended, canceled or added herein.

The Office Action of November 14, 2008 has been carefully considered by Applicants. Reconsideration is respectfully requested in light of the following remarks.

I. Claim Rejections under 35 U.S.C. § 112

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In particular, the Office Action states, “The Examiner has searched the specification and cannot find any standard for a “successful” comparison (specifically what is successful and what is not), and a standard for “a sufficient level of satisfaction” (what is satisfying and what is not).” Applicants respectfully traverse.

At issue is whether the step, “confirming whether said configuration file has been successfully compared to said custodial file to a sufficient level of satisfaction” is indefinite. Applicants respectfully submit that the language of this claim step is not indefinite, since one of skill in the art would understand exactly what is meant by the terms of this step within the relevant context of authenticating configuration data by comparing files. Whether one file has or has not been successfully compared to another file to a sufficient level of satisfaction is a relatively straightforward and simple confirming process that is discussed and alluded to throughout the specification. For example, portions of at least paragraphs [0047], [0051] and [0060] of the specification as filed relate to the relevant comparing and confirming files concept, using language such as “if the data is correct” and/or “if a match is verified.”

Furthermore, the terms “successful” comparison and “sufficient level of satisfaction” are simply user based criteria. The “standards” for a successful comparison or sufficient level

of satisfaction with respect to such a confirming step can be varied based upon what is desired by the individual user or programmer, and as such are not critical to the scope of the claim.

While one user might require a 100% bit by bit matching of data files, another user might use a standard that permits for some percentage of errors and/or different or “mismatched” data for headers, file signatures, or other file data items that do not affect operations. Regardless of which “standard” is used, the claims are intended to and are enabled to cover any and all such standards. Rejecting these particular terms within the context provided as indefinite is akin to rejecting a “blue widget” for being indefinite because the specification does not define what is blue. Those of skill in the art understand what a “successful” comparison of one data file to another is within the computing arts, just as those of skill in the art understand what “blue” is.

In sum, one of skill in the art would simply understand the confirming step at issue to mean exactly what it states, with the “successful” and “sufficient level of satisfaction” elements being defined as desired by the relevant user or programmer. As such, claim 1 is not indefinite for using these terms within the context provided. Accordingly, withdrawal of the pending § 112, second paragraph, rejections is respectfully requested.

II. Double Patenting

Claims 1-20 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 7,108,605 to LeMay, et al. (“LeMay”). In particular, the Office Action states, “Although the conflicting claims are not identical, they are not patentably distinct from each other.” Applicants respectfully traverse.

In so traversing, Applicants incorporate by reference all remarks made in Applicants’ prior Response of August 22, 2007. While Applicants disagree with the mischaracterizations of LeMay made in the “Response to Arguments” section of the pending Office Action, further dispute or discussion on these points is ultimately moot and thus unnecessary.

In support of the pending double patenting rejections, the Office Action misapplies the relevant standards of patent law and uses an improper application of LeMay. In fact, the § 103 rejections from the previous action have simply been repeated verbatim in the current Office Action, despite the admission in the Office Action that LeMay is indeed unavailable as a § 103 reference, and despite the relevant standards and applications of prior art for double patenting rejections and § 103 rejections being entirely different.

In particular, a nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but the relevant examined claim is not patentably distinct from the reference claim because the relevant examined claim is either anticipated by, or would have been obvious *over the reference claim*. See, MPEP 804(II)(B)(1). As such, the appropriate comparison is between the pending claims and the reference claim at issue, *not the entire reference*, as has been done here in rehashing the admittedly improper § 103 rejections.

Furthermore, any quick comparison of the pending claims with any issued claim of LeMay finds that there are numerous reasons to conclude that *these claims are patentably distinct from each other*. In the event that the pending double patenting rejections are to be maintained, Applicants respectfully request clarification as to which claim elements of which claims of LeMay are deemed to require a configurator having a read only configuration file, a read only custodial file residing in a location separate from the configurator, an element wherein at least a substantial portion of the custodial file is identical to at least a substantial portion of the configuration file, and the step of comparing at least a representative portion of data from the configuration file with at least a representative portion of data from the custodial file, as well as all other elements from each of the presently pending claims.

In sum, the pending rejections do not present a *prima facie case* for double patenting, because they do not make the appropriate comparison to an *issued claim*, as required by law. As such, withdrawal of the pending double patenting rejections is respectfully requested.

CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability, and accordingly request a Notification of Allowance to that effect. It is believed that no fees are due at this time. Should any fee be due in connection with this paper or for this application in general, then the Commissioner is hereby authorized to charge such fee or fees to Deposit Account No. 50-0388, referencing Docket No. IGT1P096. If there are any questions or issues remaining, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,
BEYER WEAVER LLP

February 14, 2008

/justinwhite/
Justin A. White, Esq.
Reg. No. 48,883

P.O. Box 70250
Oakland, CA 94612-0250
(408) 255-8001